

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRED FREY

Appeal No. 97-2461
Application 29/020,294¹

ON BRIEF

Before GARRIS, LEE, and NASE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of the following design claim:

The ornamental design for the sleeve, as shown and described.

The sleeve design is depicted in the respective views of figures 1 to 3. New figures 2 and 3 were added by amendment after final Office Action, to replace previously unapproved addition of different figures 2 and 3. In an advisory Office

Application for patent filed March 23, 1994.

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Action (Paper No. 8), the examiner indicated that the drawing correction had been approved. Also in the advisory Office Action, the examiner indicated that a previous rejection made under 35 U.S.C. § 112, has been overcome. Thus, the only rejection on appeal is that for obviousness under 35 U.S.C. § 103. The examiner has relied on:

Carter U.S. Patent No. 5,173,967 Dec. 29, 1992

Opinion

We do not sustain the rejection of the sole design claim under 35 U.S.C. § 103 as being unpatentable over the design of Carter's Figure 4.

One of ordinary skill in the art to which the subject matter pertains in design cases is a designer of ordinary capability who designs articles of the type presented in the application. In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). Moreover, for determining the obviousness of designs, the Court of Customs and Patent Appeals has stated in In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982):

Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.

It is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration. In re Rosen, 673 F.2d at 390, 213 USPQ at 349.

The appellant's figures 1-3 together show a tubular sleeve which has the same look all the way around. As is stated in the specification on page 1, "it should be understood that all other side views are substantially equal to Fig. 1."

Contrary to the examiner's view, we do not find that Carter satisfies the basic requirement of a Rosen reference. Being tapered is not the only feature of the appellant's design. Continuity, and smoothness as reflected in the appellant's tubular design are also distinctive and cannot be ignored. Carter's design, on the other hand, as is shown collectively in figures 3 and 4 has substantial overlap and a stacked appearance at the edges of the overlap.² Carter's sleeve is wrapped onto the user's arm and fastened together where the edges meet. In our view, Carter is clearly not a Rosen reference which embodies fundamentally or substantially similar basic design concepts.

In any event, even assuming that Carter constitutes a Rosen reference, the rejection still cannot be sustained. Whether or

Figure 4 alone does not illustrate the whole design.

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not the primary reference relied on for the rejection satisfies the requirements of a Rosen reference, the differences between the claimed design and that of the prior art reference still must be accounted for in a reasonable and meaningful manner.

Here, they have not.

We disagree with the examiner's apparent view that the difference between the appellant's design and that of Carter reflects mere minute details or small variations which can be dismissed or ignored. Rather, the difference must be accounted for from the perspective of an ordinary designer in this art. It is of no help to the examiner that Carter's specification states: "the amount of closure along the lateral edges is determined by the severity of the element that you are trying to protect the leg or arm from" (column 1, lines 56-59). Carter uses fasteners to achieve full closure. In column 4, lines 48-51, Carter states: "any amount of hook and loop fasteners can be used along the lateral edge to produce the necessary amount of protection for the user." Thus, even when "fully closed," Carter's sleeve still exhibits the overlap and lack of continuity that is far different from the look of the appellant's continuous tubular design. Note that Carter's method of applying fasteners, preferably hook and loop, to the lateral edges 48 is shown in

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figures 14 and 15. Also, to the extent that markings or hatchings in the appellant's figures may indicate the use and look of fabric, that aspect of the appellant's design has not been addressed by the examiner in the context of Carter.

It is also of no help to the examiner's position that the examiner's answer states at page 5:

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Further, tubular sleeves are known in the prior art. The prior art reference to Upham patented June 21, 1881 clearly shows that tubular sleeves are old in the prior art.

We express no view as to whether Upham constitutes a Rosen reference or whether it in combination with any other reference would have rendered obvious the appellant's design. There simply is no occasion to consider Upham in this appeal. The rejection is one based on Carter alone. Note that all references on which the examiner relies should be positively recited in the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Movva, 31 USPQ2d 1027, 1028 n.1 (Bd. Pat. App. & Int. 1993); Ex parte Hiyamazu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Int. 1988). Since Upham has not been recited in the basis of the obviousness rejection, it will not be treated as such.

For the foregoing reasons, the rejection of the sole design claim under 35 U.S.C. § 103 as being unpatentable over Carter cannot be sustained.

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Conclusion

The rejection of the sole design claim under 35 U.S.C. § 103
as being unpatentable over Carter is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
JAMESON LEE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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Lerner and Greenberg
P.O. Box 2480
Hollywood, FL 33022-3480